



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,139	01/24/2005	Arnold Keller	246472007300	9203
25227	7590	12/27/2005	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			SWEET, THOMAS	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/522,139

Applicant(s)

KELLER, ARNOLD

Examiner

Thomas J. Sweet

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/24/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/05, 1/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

It is noted that this application appears to claim subject matter disclosed in prior Application No. EP 03/08196, filed 7/25/03 and EP 2016768.0, filed 7/26/02. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an

Art Unit: 3738

unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “in front of the areas of normal contact , sloping upward” and “sloping upward behind the areas of normal contact” (claim 1), “the rotation axis is displaceable in relation to the femoral and tibial prosthesis parts in an

Art Unit: 3738

anteroposterior direction” (claim 3), and “condylar sliding surface ... has a radius of curvature that is substantially constant in the flexion plane” (claim 4-6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because figure 3 is a cross section unidentified in another figure (for example, a cut away at 21 in figure 2). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing

Art Unit: 3738

figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The written description and drawings do not disclose any means or structure contemplated such that "the rotation axis is displaceable in relation to the femoral and tibial prosthesis parts in an anteroposterior direction" is possible.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufer et al. (US 3,868,730). Kaufer et al. discloses a knee prosthesis (all figs.), comprising a femoral prosthetic part (at 16) which forms a pair of condylar sliding surfaces (at 22, in figs. 2 and 3), with a tibial part (at 18) which has tibial sliding surfaces (at 38) configured for cooperating with the condylar sliding surfaces (as shown in the figs), and a coupling part (at 44) which connects the femoral and tibial parts, so that they are full capable of rotate about a rotation axis (thru 44) approximately parallel to a tibial shaft (approximately thru 48) when implanted (the ball 34 is a gimbal allowing rotation around many axes, including the one thru 44), the tibial sliding surfaces having areas of normal contact (such as shown in fig. 5) which, when the femoral and tibial parts , have the same anteroposterior alignment (as in fig. 5), cooperate with corresponding condylar sliding surfaces, in front of the areas of normal contact , sloping upward (as seen in fig. 5) with a radius of curvature much greater than the radius of curvature of the portion of the corresponding condylar sliding surface (col 3, lines 19-31 and the abs.- describe the curvature of 38 corresponding to the lower condyle runner which is of greater radius than the upper condyle runner contacting the tibial portion in fig. 5) cooperating with the tibial sliding surface (as shown), and sloping upward behind the areas of normal contact (as shown in fig. 5) is fully

Art Unit: 3738

capable, in the event of rotation, each of the condylar sliding surfaces (at 22) remains in contact with its corresponding associated tibial sliding surface (at 38) in front of or behind the area of normal contact.

With regard to claim 3, the rotation axis is displaceable in relation to the femoral and tibial prosthesis parts in an anteroposterior direction (being gimbaled allows the axis of rotation to tilt forward and back).

With regard to claim 4-6, a portion (the upper condyle runner) of the condylar sliding surface corresponding to the tibial sliding surface has a radius of curvature that is substantially constant in the flexion plane (abs).

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Crabtree et al. (US PGpub 2005/0107886). Crabtree et al. discloses a knee prosthesis (all figs.), comprising a femoral prosthetic part (at 100) which forms a pair of condylar sliding surfaces (at 102), with a tibial part (at 200) which has tibial sliding surfaces (at 302) configured for cooperating with the condylar sliding surfaces (as shown in the figs.), and a coupling part (at 400) which connects the femoral and tibial parts, so that they are full capable of rotate about a rotation axis (thru 210) approximately parallel to a tibial shaft (approximately thru 208) when implanted, the tibial sliding surfaces having areas of normal contact (such as shown in figs. 6A-6B) which, when the femoral and tibial parts , have the same anteroposterior alignment (as in figs. 6A-6B), cooperate with corresponding condylar sliding surfaces (at 102), in front of the areas of normal contact , sloping upward (as seen in fig. 6B) with a radius of curvature much greater than the radius of curvature of the portion of the corresponding condylar sliding surface

Art Unit: 3738

([0030] and [0033] - describe the curvature of 302 corresponding condyles as shown in the figs., [0033] and the condyles have at least two radii, the greater radius at the posterior verses the distal condyles [0030]) cooperating with the tibial sliding surface (as shown), and sloping upward behind the areas of normal contact (as shown in fig. 6A) is fully capable, in the event of rotation, each of the condylar sliding surfaces (at 102) remains in contact with its corresponding associated tibial sliding surface (at 302) in front of or behind the area of normal contact (at a flexion between 0 and 45 degrees).

With regard to claim 2, the rotation axis is fixed (thru 210) in relation to the femoral and tibial prosthesis parts, in an anteroposterior direction.

With regard to claims 4 and 5, the condylar sliding surface corresponding to the tibial sliding surface has a radius of curvature that is substantially constant in the flexion plane.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matthews et al. (US 4,094,017), Elloy et al. (US 4,950,297), Murray et al. (US 4,224,697), Leclercq et al. (US 6,558,427), Bosredon (US 6,117,175) and WALKER (WO 200113825)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tjs



CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700